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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/525,732

**Applicant(s)**

PODHAJSKY ET AL.

**Examiner**

NANCY MEHTA

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-14, 16-, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application***

This office action is in response to the amendments and arguments filed by applicant on 06/06/2008.

- Claims 1, 12-14, 17, 18, 20, 30, 33, 36, and 37 are amended
- Claims 10, 11, 16, 29, 34, and 35 are cancelled. Claims 2, 15, 19, 21, and 38 were previously cancelled.
- No new claims are added
- Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are pending

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14, 17, 18, 33, 36, and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 18 and 37 are directed toward instructions, but do not clearly state computer instructions. Since instructions are information signals, and such claims do not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming

nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory [See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”)]. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer [See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)]. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process, and as such is nonstatutory functional descriptive material.

Claims 14, 17, 33, and 36 are directed towards methods that involve performance of steps but there is not computer medium to perform the steps, as such these claims are not tied to any other statutory class. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class, such as a particular apparatus, or (2) transform underlying subject matter, such as an article or materials, into a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n. 9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70-71 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-9, 12 -14, 17, 18, 20, 22-28, 30-33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, et al. [U.S. Pat. Pub. 2002/0092004].

Regarding Claim 1, Lee, et al. discloses, A business application generation system for automatically generating a business software application, comprising:

a central processing unit;

a repository containing a set of meta data;

a generation tool comprises a first tool and a second tool, said first tool being a meta data dependent passer element and said second tool being a meta data independent generating element (**¶37, 38, 40**); and  
input/output means for treating said meta data and for invoking said generation tool [[:]],  
said input/output means being a workbench enabling editing of said meta data (**¶29**),  
wherein:

said workbench enables the invocation of said generation tool by initiating an import of said set of meta data into said passer element (**¶37, 38, 40**)

said passer element handles, interprets, and processes said set of meta data for input to said generating element (**¶37, 38, 40**),

said generating element generating, on the basis of said data input, program code for said business process application (**¶37, 38, 40**),

said set of meta data containing structured business process application information comprising information on functions operating on data, and said generation tool retrieving data from said repository and, on the basis of said retrieved repository data, generating a customized business process application.

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**(Fig. 1, 10, ¶10)**

Lee, et al. does not explicitly disclose,

Business data

However, Lee, et al. discloses a business process application which contains data. It is obvious that the data could be considered business data.

Regarding Claim 3, Lee, et al. further discloses, wherein said set of meta data consists of data base tables containing meta data entities.

**(¶64)**

Regarding Claim 4, Lee, et al. further discloses, wherein said meta data entities contain information on the identification of an application to be generated, on object types and on object structures.

**(¶64)**

Regarding Claim 5, Lee, et al. further discloses, wherein said object types contain information on the business process data to be processed by the application to be generated and on functions operating on said business process.

**(¶10, 64)**

Regarding Claim 6, Lee, et al. does not explicitly disclose, wherein said business process is a billing process.

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However, it is well known in the art at the time of the invention that a billing process is a business process.

Regarding Claim 7, Lee, et al. does not explicitly disclose, wherein said business process is a bonus payment process.

However, it is well known in the art at the time of the invention that a bonus payment process is a business process.

Regarding Claim 8, Lee, et al. does not explicitly disclose, wherein said business process is a commission payment process.

However, it is well known in the art at the time of the invention that a commission payment process is a business process.

Regarding Claim 9, Lee, et al. further discloses, wherein said input/output means is a workbench enables at least one of viewing, creating, adding, deleting, changing, inheriting, and editing of said repository meta data.

**(¶29)**

Regarding Claim 12, Lee, et al. further discloses, wherein said generating element further generates data objects for said business process application.

**(¶10, 64)**



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Regarding Claim 13, Lee, et al. further discloses, wherein said generating element further generates a data base for said business process application.

**(¶10, 64)**

Regarding Claim 14, Lee, et al. discloses, A computer-based method for generating a business software application, comprising:

providing a set of meta data containing information on the business process data to be processed by the application to be generated and on functions operating on said business process data;

customizing said set of meta data via an input/output means before said meta data is imported into a generation tool, said generation tool comprising a meta data dependent passer element and a meta data independent generating element for generating a customized business software application (¶39);

[[and]] importing said set of meta data comprising information on functions into a said passer element of generation tool [[comprising a meta data dependent passer element and a meta data independent generating element for generating a customized business software application]] **(Fig. 1, 10, ¶10, 37, 38, 40)**

handling, interpreting, and processing said set of meta data imported into said generation tool in said meta data dependent passer element [37-40]; and

inputting said set of meta data after processing in said passer element into said generating element [37-40].

Lee, et al. does not explicitly disclose,

Business process data

However, Lee, et al. discloses a business process application which contains data. It is obvious that the data could be considered business process data.

Regarding Claim 17, Lee, et al. further discloses, further comprising the steps of inputting said set of meta data after processing in said passer element into said generating element, and generating program code for said business process application on the basis of said data input.

**(Fig. 1, 10, ¶10, 37-40)**

Regarding Claim 18, Lee, et al. discloses, A computer program product comprising a computer readable medium, the computer readable medium comprising instructions for carrying out a method for generating a business software application, the method comprising:

customizing a set of meta data via an input/output means before said meta data is imported into said generation tool, generation tool comprising a meta data dependent passer element and a meta data independent generating element (¶39);

importing said set of meta data into said passer element of said generation tool [[comprising information on functions into a generation tool, said generation tool comprising a meta data dependent passer element and a meta data independent generating element]] **(Fig. 1, 10, ¶10, 37-40),**

on the basis of said set of meta data, processing meta data in said passer element, inputting said processed meta data in said generating element and generating a customized software application (**Fig. 1, 10, ¶10, 37-40**)

Lee, et al. does not explicitly disclose,

Customized business software application

However, Lee, et al. discloses a business software application as well as a customized software application. It is obvious that the customized software application could be considered a business software application.

Regarding Claim 20, Lee, et al. discloses, A business application generation system for automatically adapting a business software application, comprising:

a central processing unit;

a repository containing a set of meta data;

a generation tool comprises a first tool and a second tool, said first tool being a meta data dependent passer element and said second tool being a meta data independent generating element (**¶37, 38, 40**); and

input/output means for treating said meta data and for invoking said generation tool [;], said input/output means being a workbench enabling editing of said meta data (**¶29**), wherein:

said workbench enables the invocation of said generation tool by initiating an import of said set of meta data into said passer element (**¶37, 38, 40**)

said passer element handles, interprets, and processes said set of meta data for input to said generating element (§37, 38, 40),

said generating element generating, on the basis of said data input, program code for said business process application (§37, 38, 40),

said set of meta data containing structured business process application information comprising information on functions operating on business data, and said generation tool retrieving data from said repository and, on the basis of said retrieved repository data, generating a customized version of an existing business process application.

**(Fig. 1, 10, ¶10, 37-40)**

Lee, et al. does not explicitly disclose,  
customized adapted version

However, Lee, et al. discloses a customized version. It is obvious that the customized version is adapted.

Regarding Claim 22, Lee, et al. further discloses, wherein said set of meta data consists of data base tables containing meta data entities.

**(¶64)**

Regarding Claim 23, Lee, et al. further discloses, wherein said meta data entities contain information on the identification of an application to be generated, on object types and on object structures.

**(¶64)**

Regarding Claim 24, Lee, et al. further discloses, wherein said object types contain information on the business process data to be processed by the application to be generated and on functions operating on said business process.

**(¶10, 64)**

Regarding Claim 25, Lee, et al. does not explicitly disclose, wherein said business process is a billing process.

However, it is well known in the art at the time of the invention that a billing process is a business process.

Regarding Claim 26, Lee, et al. does not explicitly disclose, wherein said business process is a bonus payment process.

However, it is well known in the art at the time of the invention that a bonus payment process is a business process.

Regarding Claim 27, Lee, et al. does not explicitly disclose, wherein said business process is a commission payment process.

However, it is well known in the art at the time of the invention that a commission payment process is a business process.

Regarding Claim 28, Lee, et al. further discloses, wherein said input/output means is a workbench [[enabling]] enables at least one of viewing, creating, adding, deleting, changing, inheriting, and editing of said repository meta data.

**(¶29)**

Regarding Claim 30, Lee, et al. further discloses, wherein said [[passer element handles, interprets, and processes said set of meta data for input to said generating element,]] said generating element generates, on the basis of said data input, program code for said business process application 30.

**(¶37, 38, 40)**

Regarding Claim 31, Lee, et al. further discloses, wherein said generating element further generates data objects for said business process application.

**(¶10, 64)**

Regarding Claim 32, Lee, et al. further discloses, wherein said generating element further generates a data base for said business process application.

**(¶10, 64)**

Regarding Claim 33, Lee, et al. discloses, A computer-based method for generating an adapted business software application, comprising:

providing a set of meta data containing information on the data to be processed by the adapted application to be generated and on functions operating on said data,

customizing said set of meta data via an input/output means before said meta data is imported into said generation tool, said generation tool comprising a meta data dependent passer element and a meta data independent generating element for generating a customized adapted business software application (¶39, 37-40); and

importing said set of meta data comprising information on functions into a generation tool comprising a meta data dependent passer element and a meta data independent generating element for generating a customized business software application.

**(Fig. 1, 10, ¶10, 37, 40)**

handling, interpreting, and processing said set of meta data for input to said generating element (¶37, 38, 40),

inputting said set of meta data after processing in said passer element into said generating element (¶37, 38, 40),

Lee, et al. does not explicitly disclose,

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business process data adapted

However, Lee, et al. discloses a business process application which contains data. It is obvious that the data could be considered business process data. Lee, et al. discloses a customized version. It is obvious that the customized version is adapted.

Regarding Claim 35, Lee, et al. further discloses, further comprising the step of handling, interpreting, and processing said set of meta data imported into said generation tool in said meta data dependent passer element.

**(¶37, 38, 40)**

Regarding Claim 36, Lee, et al. further discloses, further comprising the steps of inputting said set of meta data after processing in said passer element into said generating element, and generating program code for said business process application on the basis of said data input.

**(Fig. 1, 10, ¶10, 37-40)**

Regarding Claim 37, Lee, et al. discloses, A computer program product comprising a computer readable medium, the computer readable medium comprising instructions for carrying out a method for generating an adapted business software application, the method comprising:



customizing said set of meta data via an input/output means before said meta data is imported into said generation tool, said generation tool comprising a meta data dependent passer element of said generation tool (**¶39**);

importing [[a]] said set of meta data into meta data dependent passer element of said generation tool, [[said generation tool comprising a meta data dependent passer element and a meta data independent generating element]]; and

on the basis of said set of meta data, processing meta data in said passer element, inputting said processed meta data in said generating element and generating a customized business software application

**(Fig. 1, 10, ¶10, 37-40)**

Lee, et al. does not explicitly disclose,

customized adapted business software application

However, Lee, et al. discloses a customized version. It is obvious that the customized version is adapted.

### ***Response to Arguments***

#### ***Argument #1***

Applicant argues that Lee fails to disclose claim limitation in which a workbench “enables the invocation of said generation tool by initiating an import of meta data into [[a]] passer element” and the passer element “handles, interprets, and processes said set of meta data for input to said generating element” as recited by claim 1.

***Response to Arguments***

The applicant's arguments have been fully considered, however, the examiner respectfully disagrees.

The examiner would like to draw applicant's attention to Lee, para [0037], "XML meta documents.....program 28", where Lee discloses the conversion of UML applications into design database files. This conversion is a modification of the application, thus Lee shows "editing" of the XML meta documents.

Also Lee shows in paragraph [0037], [0038], the generator program (28), which is the first tool, and design program (28), which is the second tool.

To further address applicant's argument, the examiner also points to paragraph [0039], where the generator program receives the XML document, processes the document by performing a series of validations on the document, and then creates a design database file and a system installation file. The system installation program further generates a generated software application. Thus the cited paragraphs read on the claim limitation "workbench enables.....passer element".

As the remaining claims depend directly or indirectly from the amended independent claims, the examiner maintains that Lee either in obvious combination or individually clearly teaches all limitations argued and presented by the applicant in the claims as currently they have been amended.

***Examiner's Note:***

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified

citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY MEHTA whose telephone number is (571)270-3265. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm, alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nancy Mehta

/Nga B. Nguyen/  
Primary Examiner, Art Unit 3692